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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,511	09/28/2001	Deral T. Mosbey	55837US002	4740

7590

05/07/2002

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EXAMINER

BERMAN, ALYSIA

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 05/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,511

Applicant(s)

LU ET AL.

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) ~~7 and 53-65~~ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. With respect to Group I and Group II, Applicant's election with traverse of Group I, claims 1-52, and a terpolymer derived from isooctyl acrylate, stearyl methacrylate and polyethylene oxide methacrylate in Paper No. 3 is acknowledged. The traversal is on the ground(s) that it would not be unduly burdensome to search the claims of Group II with the claims of Group I. This is not found persuasive because the claims of Group I do not require the steps of the claims of Group II for the claimed purposes. A reference anticipating or rendering obvious the claims of Group I would not necessarily anticipate or render obvious the claims of Group II. A separate search and examination would have to be conducted for each of the groups.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 53-61 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 3.

3. With respect to Group I and Groups III and IV, Applicant's election of Group I, claims 1-52, in Paper No. 3 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement between Group I and Groups III and IV, the election with respect to these Groups has been treated as an election without traverse (MPEP § 818.03(a)).

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4. Claims 62-65 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 3.

Information Disclosure Statement

5. The information disclosure statement filed September 28, 2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the ICI Companies Datasheet, "ICI Surfactants Arlacel® P135 Polymeric Emulsifier," is undated. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims ~~1-6, 8-28~~¹⁻²⁸, 32-36, 38-40 and 42-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5/13/02

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8. Claims ¹⁻²⁸~~1-6, 8-28~~, 32-36, 38-40 and 42-48 are vague and indefinite because it is unclear what Applicant intends by alkyl-Y containing side chains with an average number of carbon atoms.

9. Claim 6 is indefinite because it is unclear what Applicant intends by skin capacitance and how one determines that this property has been reduced.

10. Claim 27 is indefinite because it contains improper Markush language.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 1-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 661 964 B1 (964) in view of EP 0 011 806 (806).

EP '964 is directed to the use of acrylate copolymers in water-in-oil cosmetic emulsions (page 2, line 3 to page, line 17). For humectants, stabilizers, antimicrobial agents and other conventional cosmetic ingredients in the emulsions see page 5, line 50 to page 6, line 29. At page 5, lines 45-49, EP '964 discloses that the emulsions preferably contain about 40-55 wt.% water and 0.25-10 wt.% acrylate polymer, which leaves about 58-35 wt.% oil. EP '964 does not teach a vinyl polymer comprising ethylene oxide containing side chains.

EP '806 discloses emulsion polymers that are useful for thickening aqueous compositions (title). The emulsion polymers are made from monomers of a carboxylic acid, a nonionic vinyl monomer and a nonionic vinyl surfactant ester (page 2, lines 26-59). The polymers are disclosed as useful in cosmetics (page 6, lines 15-16). Claims 17-21 do not require the emulsion to contain a bioactive agent. It is within the skill in the art to select optimal parameters in a composition in order to achieve a beneficial effect. *In re Boesch*, 205 USPQ 215 (CCPA 198). "It is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Only if the "results optimizing a variable" are "unexpectedly good" can a patent be obtained for the claimed critical range. *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977); see also *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (in banc). It would have been obvious for one skilled in the art to vary the proportions of components in a composition to arrive at the best compositions for the intended purpose. Absent

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evidence of unexpected results, the proportions of components in the emulsion are not given patentable weight.

Chemical compounds and compositions containing the same components as instantly claimed would be expected to exhibit the same properties absent evidence to the contrary. Applicant has not provided any evidence of record to show that the polymers and compositions of the prior art do not exhibit the instantly claimed. Because the claims directed to moisturizing, tissue antiseptic, personal care and transdermal drug delivery compositions do not require any additional limitations, the compositions of the prior containing the same components as instantly claimed would be expected to be suitable for any one of these purposes. The preambles of the claims are not given patentable weight over the prior art. *In re Tuominen*, 213 USPQ 89, *In re Pearson*, 181 USPQ 641. Pearson stated that a known composition could not be patented solely on preamble use. Terms merely setting forth an intended use for, or a property inherent in, an otherwise old composition do not differentiate the claimed composition from those of the prior art. *In re Pearson*, 181 USPQ 641. Difference in use cannot render claimed composition novel. *In re Tuominen*, 213 USPQ 89. Discovery of a new property or use of a previously known composition, even if unobvious from the prior art, cannot impart patentability to claims to a known composition. *In re Spada* 15 USPQ 1655 and MPEP 2112.01.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the water-in-oil emulsion of EP '964 and add the polymers of EP

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'806 with a reasonable expectation of providing thickened water-in-oil cosmetic emulsions.

14. Claims 1-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 661 964 B1 (964) in view of US 4,552,685 (685).

EP '964 teaches all the limitations of the claims as stated in the 35 U.S.C. 103(a) rejection above. It does not teach a vinyl polymer comprising ethylene oxide containing side chains.

US '685 teaches that copolymers of an unsaturated carboxylic acid, a polyethylene oxide methacrylate and an alkyl acrylate are useful surfactants and thickeners in cosmetics (abstract, col. 2, line 30 to col. 3, line 15). See above the issues of amounts of components, properties exhibited by the compounds and the compositions and the preambles of the claims.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the water-in-oil emulsions of EP '964 and add the copolymeric surfactant/thickeners of US '685 with the reasonable expectation of providing thickened water-in-oil cosmetic emulsions.

Unexpected Results

15. It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to

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any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

In the instant case, no data has been presented.

Allowable Subject Matter


16. It appears that Applicants' elected species of vinyl polymer would be allowable over the prior art if presented in an independent claim.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
April 30, 2002


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PRIMARY EXAMINER
GROUP 1200